

REMARKS

Claims 19-27 and 32-33 are currently pending in the present application, of which claims 19 and 32 are independent. Claims 1-11 were previously cancelled and claims 12-18, 28-31, and 34-26 have been withdrawn without prejudice. Claims 19-27 and 32-33 have been rejected.

35 U.S.C. §102(b)

Claims 19-20, 23-27, and 32-33 have been rejected under 35 U.S.C. §102(b) as being anticipated by Barwick, et al. (U.S. Patent No. 5,700,240) (hereinafter, "Barwick"). Applicant respectfully traverses this rejection for at least the following reasons.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). For a reference to anticipate a claim under 35 U.S.C. §102, "the identical invention must be shown in as complete detail as is contained in the claim." MPEP §2131 citing Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1566 (Fed. Cir. 1990).

Barwick fails to teach each and every element of the pending claims. The Examiner asserts that "[t]he Barwick patent discloses a handpiece (30), a control console (column 1, line 67), irrigation and aspiration sources for removing fluid, and a matrix comprising power levels and fluid flow conditions" and reproduces Figures 1 and 1A for support. Office Action mailed December 7, 2009, p. 3. The Examiner fails to provide any showing how Barwick teaches a matrix comprising phaco power levels and fluid flow conditions or power level, power duty cycles, and fluid flows that will not generate sufficient heat to create damage to eye tissue within the eye. A mere conclusory statement does not satisfy his duty of establishing that the claims are anticipated by Barwick. Contrary to the Examiner's conclusory statement, Barwick does not teach or suggest this element. In fact, Barwick is silent as to a matrix and is silent about with not generating sufficient heat to damage eye tissue. Therefore, since Barwick fails to teach each and every element of claim, it fails to anticipate the claims.

35 U.S.C. §103(a)

Claims 21 and 22 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Barwick in view of Costin (U.S. Patent No. 5,733,256) (hereinafter, "Costin") or Lo, et al. (U.S. Patent No. 4,954,960) (hereinafter, "Lo"). Applicant respectfully traverses this rejection for at least the following reasons.

35 U.S.C. §103(a) sets forth in part:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said matter pertains.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all of the claim limitations. MPEP §2142; Verlander v. Garner, 248 F.3d 1359, 1363 (Fed. Cir. 2003).

The Examiner has failed to establish a *prima facie* case of obviousness and the currently pending claims are not rendered obvious in light of Barwick in view of Costin or Lo.

As discussed above, Barwick fails to teach or suggest a matrix comprising phaco power levels and fluid flow conditions that will not generate sufficient heat to create damage to eye tissue within the eye. The Examiner cites Costin and Lo for teaching a flow sensor or a temperature sensor, which he acquiesces is not taught in Barwick. However, even assuming *arguendo* that those elements are taught by Costin and Lo, the references fail to make up for the deficiency of Barwick. Costin and Lo are both silent as to a matrix comprising phaco power levels and fluid flow conditions that will not generate sufficient heat to create damage to eye tissue within the eye as claimed.

Thus, the cited references individually and in combination, fail to teach or suggest each and every element of the claimed invention and thus, fail to render the presently claimed invention obvious.

Based upon the totality of the foregoing, Applicant respectfully submits that claims 19 and 32, are allowable over the references of record, as well as the claims that depend therefrom.

Accordingly, it is respectfully submitted that all pending claims fully comply with 35 U.S.C. § 103.

CONCLUSION

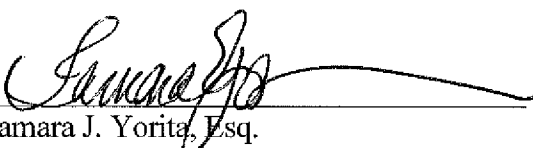
It is respectfully submitted that all claims of the present application are in condition for allowance. Consideration and allowance of all pending claims at an early date is respectfully requested.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Should any additional fees be due, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment to Deposit Account No. 502317. Should the Examiner have any questions or concerns, please do not hesitate to contact the undersigning attorney at 714-247-8422.

Respectfully submitted,

Date: March 8, 2010



Tamara J. Yorita, Esq.
Registration No. 53,813
Customer No. 33357